



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671

23446 7590 10/22/2004

MCANDREWS HELD & MALLOY, LTD  
500 WEST MADISON STREET  
SUITE 3400  
CHICAGO, IL 60661

EXAMINER

FLYNN, KIMBERLY D

ART UNIT PAPER NUMBER

2153

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/385,802

Applicant(s)

BARTHOLOMEN DONOVAN,  
KEVIN REMINGTON JOS

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10-20 and 22-102 is/are pending in the application.
- 4a) Of the above claim(s) 25-102 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 25-102 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to an Amendment filed July 28, 2004. Claims 1-8, 10-20, and 22-102 are presented for further consideration. Newly added claims 25-102 are withdrawn from consideration as being directed to a non-elected invention. See below.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-8, 10-20, and 22-24 are drawn to a distributed communication system in which a plurality of users associated with different realms access the Internet via a corresponding PC through a service provider, a device for providing instant messaging between users classified in Class 709, subclass 204.

II. Claims 25-102 are drawn to system, method and computer readable medium for multi-protocol messaging communication on a computer network comprising a user interface, a first and second service provider, an application program interface, and a conversion platform for converting data entered through the user interface to at least one of the first and second communication protocols for communication over the computer network classified in Class 709, subclass 206.

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as establishing a connection from the first and second users based their current IP address and characteristic

Art Unit: 2153

protocol classified in different Classes/subclasses. And, this Invention, Invention I, as claimed does not require the particulars of Invention II as claimed because Invention I does not explicitly require the user interface module to permit user entry of data, the application program interface, or the conversion platform for converting data defined by at least one of the data structures of the application program interface in order to allow access to the Internet and establish connections between a plurality of users associated with different realms.

Invention II has separate utility such as a system for providing multi-protocol messaging communication on a computer network classified in a different Class/Subclass. See M.P.E.P. § 806.05(d).

3. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

4. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (1-8, 10-20, and 22-24) would require use of search Class 709, subclass 204 ( not required for the invention II).

(b) the Group II search (claims 25-102) would require use of search Class 709, subclass 206 (not required for the invention I).

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructive elected by original presentation for prosecution on the merits. Accordingly, claims 25-102 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R 35 § 1.142(b) and M.P.E.P. § 821.03.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1-8, 10-20, and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Auerbach (U.S. Patent NO. 6,549,937 hereinafter Auerbach).

In considering claim 1 and 24, Auerbach discloses a distributed communication system in which a plurality of users associated with different realms access the Internet via a corresponding PC through a service provider, a device for providing instant messaging between the users, the device comprising:

an IM manager associated with the PC of a first user and arranges to obtain a foreign protocol for communicating with another realm (col. 7, lines 10-17); and

an IM server including an IM database with a listing of users currently connected to the Internet, each having a unique identifier (col. 6, lines 14-28);

the IM manager being further arranged to receive the unique identifier of a particular user associated with the another realm from the IM server and to establish connection to the other user using a foreign protocol (col. 10. lines 48-51, and lines 56-64 see also col. 11, lines 32-38).

In considering claim 2, Auerbach discloses wherein a local database is arranged to store a plurality of foreign protocols, each protocol being associated with a corresponding different realm (*The database containing a plurality of foreign protocols being associated with different realms is an inherent feature of the conversion platform (112) and the protocol services modules (130), which provides a conversion between the different protocols of the different service providers to allow a client application to communicate with servers of multiple service providers*)

In considering claim 3, Auerbach discloses wherein the IM server is arranged and constructed to connect to the Internet and to receive and transmit information to and from the IM manager via the Internet (col. 6, lines 65-67 through col. 7, lines 1-17).

In considering claims 4, Auerbach discloses wherein the IM database is arranged to store information related to all users (col. 6, lines 21-28).

In considering claim 5, Auerbach discloses a display arranged to show a list of current friends of a user and a selector operated by the user to select a friend from the list to establish communication (col. 6, lines 8-13 and lines 29-42).

In considering claim 7, Auerbach discloses wherein the users are arranged to communicate over the Internet by different SPs wherein the IM database is incorporated into one of the SPs (col. 4, lines 51-58).

In considering claim 8, Auerbach discloses an IM service provider wherein the IM database is incorporated into the IM service provider (col. 5, lines 49-53).

In considering claim 10 and 22, Auerbach discloses wherein each of the first and second devices is arranged to display a window on the screen, the window identifying a

list of friends of the corresponding user, the friends being currently on line (col. 6, lines 8-10).

In considering claim 12, Auerbach discloses wherein each of the devices is adapted to receive commands from the respective user to establish a first IM session between the first user and the second user and a second IM session between the first user and a third user, the third user being identified in the window (col. 8, lines 61-66).

In considering claim 15, Auerbach discloses wherein the first device is adapted to show characteristics of the friends (col. 11, lines 4-12).

In considering claims 6 and 16, the claims include limitations that are inherent of instant messaging systems and limitations that are substantially the same as claims 1 and 24; therefore the same grounds of rejection are applicable.

In considering claim 11, Auerbach discloses wherein the first device is adapted to display a message area in one of the windows and a separate window *(Although not explicitly stated the aforementioned limitation is an inherent feature of instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication, as displaying a message area in one of the windows and a separate window is one of those inherent features.*

In considering claim 13, Auerbach discloses wherein the first device is adapted to allow the first user to switch between the first IM session and the second IM session, the first and second IM session being active simultaneously *(Although not explicitly stated, the aforementioned limitation is an inherent feature of instant messaging systems.*

*Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication, as allowing the first user to switch between the first IM session and the second IM session, the first and second IM session being active simultaneously is one of those inherent features.*

In considering claim 14, Auerbach discloses wherein the first device is adapted to display in the message area messages with the second user during the first IM session and messages with the third user during the second IM session *(The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication, as the aforementioned limitation is one of those inherent features.*

In considering claim 17, Auerbach discloses wherein each time one of the first and second users access the Internet, the corresponding device sends a message to an IM database indicating the corresponding user is online and the current IP address *(The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication, as sending a message to an IM database indicating the corresponding user is online and the current IP address is one of those inherent features.*

In considering claim 18, Auerbach discloses wherein the step of determining the current IP address comprises retrieving the address from the IM database *(The*



*aforementioned limitations are inherent features of the instant messaging systems, particularly when users access the Internet to establish a session.*

In considering claim 19, Auerbach discloses sending a connection request from the first to the second device for establishing the instant message session (*The aforementioned limitations are inherent features of the instant messaging systems. It is inherent when establishing a session to send a connection request from one device to the other*

In considering claim 20, Auerbach discloses generating a response to the connection request by the second device accepting the connection request (*The aforementioned limitations are inherent features of the instant messaging systems. It is inherent when establishing a session to generate a response to a request either accepting or rejecting the request.*

In considering claim 23, Auerbach discloses displaying the window with a message area the message area being used to indicate messages between users (*The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multi-protocol communication, as displaying the window with a message area, the message area being used to indicate messages between users, is one of those supported features.*

***Response to Amendment***

7. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Auerbach reference. An Affidavit under 37 CFR 1.131 must be filed in order to overcome the Auerbach reference.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-8, 10-20, and 21-24 have been considered but are not persuasive.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kimberly D Flynn  
Examiner  
Art Unit 2153

KF  
October 14, 2004



FRANTZ B. JEAN  
PRIMARY EXAMINER